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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,035	02/27/2002	Robert Kincaid	1001011076-1	6480

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Agilent Technologies, Inc  
Legal Department, DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, CO 80537-0599

EXAMINER

SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/087,035

Applicant(s)

KINCAID, ROBERT

Examiner

Carolyn L. Smith

Art Unit

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 9 and 38.  
Claim(s) rejected: 1-11, 22, 27, 28, 31-37 and 41.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

MARJORIE A. MORAN  
PRIMARY EXAMINER

*Marjorie A. Moran*  
12/16/06

Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 USC 112, 2nd paragraph rejections are withdrawn due to the cancellation of rejected claims 38-40. 35 USC 112, 1<sup>st</sup> paragraph, rejections are withdrawn as Applicant has pointed to additional written support which is deemed adequate.

Continuation of 11. does NOT place the application in condition for allowance because: the claim objections for claims 9 and 38 and the 35 USC 102 rejection for claims 1-11, 22, 27-28, 31-37, and 41 are maintained.

#### Claim objections

Applicant argues that the Examiner should not insist on their own preferences regarding placement of commas. This statement is found unpersuasive as the objections are objective. The commas are grammatically improper.

#### 35 USC 35 USC 102 rejection

Applicant argues that during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. This statement is acknowledged. Applicant recites a portion of paragraph 0071 which mentions sequence curation. It is noted that this passage is not a clear and concise definition of "curating", but rather exemplifications including "such as" terminology. Therefore, the Examiner is expected to interpret the claim language broadly and reasonably. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., paragraph 0071) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues about the definition of "curation". This statement is found unpersuasive the term "curation" isn't present in the instant claims. It is noted that "curate" according to the Merriam Webster online dictionary means "to act as curator of".

Applicant summarizes the Zhou et al. reference. Applicant argues that if the vendor's database does not contain a probe for the customer-selected gene of interest, curating the gene sequence followed by selection of at least one probe specific for the curated sequence will fail. This statement is found unpersuasive as the steps in the method do not have to "follow" any particular order, they only have to be present. Applicant's arguments about hypothetical situations of the vendor's database in Zhou et al. are deemed unpersuasive as the instant claims do not recite a database. The limitations recited in the instant claims are addressed in the 35 USC 102 rejection set forth in the FINAL action, mailed 12/9/05. Applicant's arguments are deemed unpersuasive for the reasons given above.